

REMARKS

By the present amendment, Claim 1 has been amended to replace the first occurrence of “the vellum part” by “a vellum part,” to be presented with separate paragraphs, and to identify the miniregions with “(i)” and “(ii).”

Further, claim 1 has been amended to clarify that the screened region is a continuous region consisting of the vellum miniregions and the reduced thickness miniregions.

Also, claim 1 has been amended to recite printed indicia on a front side and on a reverse side of the screened region of said security paper, these indicia forming patterns that are observed in reflected light and said patterns make up a final representation that is observed in transmitted light.

Withdrawn claim 4 has been amended accordingly.

Claims 1-20 are pending in the present application. However, claims 4-10 and 13-20 are withdrawn from consideration following a restriction requirement. Accordingly, only claims 1-3, 11, and 12 are currently under consideration.

I. **Restriction requirement**

In the Office Action, the restriction requirement is maintained and made final. It is alleged in the Office Action that the cited document US 7,429,062 to Fan et al. (“Fan”) discloses the subject matter of claims 1 and 4 so that unity of invention is not present.

The restriction requirement is respectfully traversed for the reasons set forth below in Part IV regarding Fan.

In addition, present claim 4 is formally dependent on elected claim 1.

Accordingly, withdrawal of the restriction requirement and consideration of all pending claims together in this application is respectfully requested.

II. Indefiniteness rejection

In the Office Action, claims 1-3 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as indefinite. It is alleged that “the vellum part” in claim 1 lacks antecedent basis.

Claim 1 has been amended to replace the first occurrence of “the vellum part” by “a vellum part.”

Accordingly, it is submitted that the rejection should be withdrawn.

III. Double-patenting rejection

In the Office Action, claims 1-3 and 11-12 are rejected under the judicially-created doctrine of obviousness-type double-patenting over claims 1-3, 5-8, 11-12, 15-17 and 22-31 of co-pending U.S. Appl. No. 10/521,555.

A Terminal Disclaimer with respect to U.S. Appl. No. 10/521,555 is submitted with this paper.

In view of the above, it is submitted that the rejection should be withdrawn.

IV. Art rejections

In the Office Action, claims 1-3 and 11-12 are rejected under 35 U.S.C. 103(a) as obvious over US 7,429,062 to Fan et al. (“Fan”).

Reconsideration and withdrawal of the rejection is respectfully requested. Fan does not have a continuous screened region consisting of alternations of (i) vellum miniregions, having an approximately constant thickness equal to that of the vellum part of the rest of the paper, and (ii)

miniregions of reduced opacity because of their smaller thickness compared with the vellum miniregions, as recited in present claim 1.

In particular, Fan only suggests applying indicia to a sheet having a uniform thickness. As a result, the miniregions (ii) of reduced opacity are absent. Even if, arguendo, the areas between indicia of Fan were considered “regions of smaller thickness” (which is denied, since these areas of Fan have the same vellum thickness as the rest of the paper of Fan), the “vellum miniregions” as in the present invention would then be absent, because the thickness of the indicia is added to that of the paper, so the regions with indicia of Fan do not have an approximately constant thickness equal to that of the vellum part of the rest of the paper.

In addition, Fan fails to teach or suggest indicia on both sides of a screened region of reduced opacity. Namely, the indicia of Fan are provided in a region having the same thickness as the rest of the paper of Fan. Therefore, opacity is inherently increased, not reduced. Even if, arguendo, the areas between indicia of Fan were considered “mini regions of smaller thickness” and the areas having the indicia “vellum miniregions” (which is denied, as discussed above), Fan does not provide any motivation or incentive to provide additional indicia to its paper, let alone indicia on both sides that form patterns observable in reflected light and in transmitted light.

In contrast, the presently claimed invention provides, as recited in present claim 1:

- a continuous screened region consisting of alternations of (i) vellum miniregions, having an approximately constant thickness equal to that of the vellum part of the rest of the paper, and (ii) miniregions of reduced opacity because of their smaller thickness compared with the vellum miniregions, and

- printed indicia on a front side and on a reverse side of the screened region of said security paper, these indicia forming patterns that is observed in reflected light and said patterns make up a final representation that is observed in transmitted light.

An advantage of this feature is that improved security can be provided by two aspects: (1) the screened region, which can provide both (a) strength via the vellum miniregions and (b) reduced opacity via the miniregions of smaller thickness, and (2) the printed indicia, which can provide improved printing quality on the screened region and improved visibility in reflected light and especially in transmitted light.

The features of the presently claimed invention and their advantages are not taught or suggested in Fan, which focuses on the image formed by printing indicia on a paper substrate having constant thickness. Therefore, the present claims are not obvious over Fan.

In addition, with respect to the dependent claims, it is submitted that the combined features of each of the dependent claims are not taught or suggested in Fan. Therefore, each of the dependent claims, and in particular claim 6, is not obvious over Fan.

In view of the above, it is submitted that the rejection should be withdrawn.

Conclusion

In conclusion, the invention as presently claimed is patentable. It is believed that the claims are in allowable condition and a notice to that effect is earnestly requested.

If there is, in the Examiner's opinion, any outstanding issue and such issue may be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Application No.: **10/541,202**
Art Unit: **1794**

Amendment under 37 CFR §1.111
Attorney Docket No.: **052737**

If this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of the response period. Please charge the fee for such extension and any other fees which may be required to Deposit Account No. 50-2866.

Respectfully submitted,

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